

REMARKS

In the Office Action of December 3, 2003, the Examiner raised a number of issues. These will be addressed below in the order presented in the above-cited Office Action.

Claims 1-3 and 5-11 are pending and under examination. All of the pending claims stand rejected. The Applicants believe that the amendments and remarks presented herein overcome all of the pending rejections/objections thus placing the application in condition for allowance.

Correction of Inventorship

In the course of assembling the present Response to Office Action of December 3, 2003 it has come to Applicants' attention that a correction of inventorship of four added inventors is in order. Applicants are submitting with this Response, a Request for Correction of Inventorship Under 37 CFR 1.48(a)(1) and newly executed Declarations for Patent Application from all 17 (previous and added) inventors along with a Statement of Inventorship Under 37 CFR 1.63 from the four newly added inventors. Applicants submit with this Response courtesy copies of the executed Assignment documents adding the four new inventors, and a copy of the Assignee Consent to Change of Inventorship (TAB 1).

In light of the above, Applicants request that the Office substitutes the true inventive entity for the erroneously named inventive entity.

Priority

In the Office Action of December 3, 2003 the Examiner notes:

Applicants are reminded that the first line of the specification contains an improper priority claim under 35 U.S.C. 120. Benefit claims under 35 U.S.C. 120 must include a specific reference to earlier filed (nonprovisional) applications for which benefit is sought. A “specific reference” requires: (1) the identification of the prior (nonprovisional) application by **application number**; and (2) an indication of the **relationship** between the nonprovisional applications; except for the benefit claim to the prior application in a continued prosecution application (CPA).

For the instant application, the specification discloses that a priority claim is made to a listing of U.S. Patents (page 1, specification), thereby failing to meet the proper requirements for the benefit under 35 U.S.C. 120.

Since the corresponding Application Serial numbers are present in the Oath and Declaration, Applicants are advised to amend the specification appropriately.

Appropriate correction is required. (Emphasis in the original.) (Office Action of December 3, 2003, page 2).

In the instant Response to Office Action of December 3, 2003, Applicants have amended the first paragraph of the Specification to indicate that the present Application is a continuation-in-part of U.S. 09/381,212 filed February 8, 2000, which claims priority to PCT/US98/05809 filed March 24, 1998, which is a PCT application that claims priority to U.S. 08/823,516 filed March 24, 1997, now issued as U.S. 5,994,069 on November 30, 1999, which is continuation-in-part of U.S. 08/759,038 filed December 2, 1996, now issued as U.S. 6,090,543 on July 18, 2000, which is a continuation-in-part of U.S. 08/756,386 filed November 29, 1996, now issued as U.S. 5,985,557 on November 16, 1999, which is a continuation-in-part of U.S. 08/682,853 filed July 12, 1996, now issued as U.S. 6,001,567 on December 14, 1999, which is a continuation-in-part of U.S. 08/599,491 filed on January 24, 1996, now issued as U.S. 5,846,717 on December 8, 1998. This application is also a continuation-in-part of U.S. 09/350,309 filed on July

9,1999, now issued as U.S. 6,348,314 in February 19, 2002, which is a divisional application of U.S. 08/756,386 filed November 29, 1996, now issued as U.S. 5,985,557 on November 16, 1999.

Information Disclosure Statement

In the Office Action of December 3, 2003 the Examiner notes that:

Applicants are advised that the U.S. Applications which have not been published nor issued as patents are cited in the IDS. (Office Action December 3, 2003, page 3.)

IDS ref # 27 is U.S. Patent Application No. 09/381,212 filed February 8, 2000. Copies of the originally filed 09/381,212 Specification and Claims together with Office Actions, and Responses to Office Actions, are sent with this Response (TAB 2).

IDS ref #30 is U.S. Patent Application No. 09/732,622 filed December 8, 2000 12/8/00, after the November 15, 2000 filing date of the instant application. IDS ref #33 is U.S. Patent Application No. 10/309,584 filed December 4, 2002, after the November 15, 2000 filing date of the instant application. Therefore, Applicants have not provided copies of ref #30 or ref #33. Nevertheless, if the Examiner wishes to have copies of refs #30 and #33, Applicants will provide them upon request.

Applicants submit herewith, a supplemental Information Disclosure Statement for consideration, together with copies of the manuscripts and Form 1449 (TAB 3). Applicants respectfully request that the Examiner fully consider the information disclosed, and indicate such consideration on the form.

Specification

In the Office Action of December 3, 2003 the examiner notes:

The disclosure is objected to because of the following informalities: On page 29 of the specification, the specification refers to Figure 29 of the Drawing, referring to regions x and y. Figure 29 of the instant application, is a figure of gel electrophoresis. It appears that description is referring to Figure 25 of the instant application.

Appropriate correction is required.

(Office Action of December 3, 2003, page 3.)

Applicants have amended the Specification to correct the designation of Figure 29 to Figure 25 on pages 42 (lines 19-21), 73 (lines 1-21), 74 (lines 2-5), 77 (lines 11-13), and 95 (lines 6-10) of the instant application. Neither Figure 29 nor Figure 25 is designated on page 29 of the Specification. In the amendments to the Specification (above) Fig. 25A is corrected to Fig. 21A on page 29 (lines 6-7) of the Specification.

Double Patenting

In the Office Action of December 3, 2003 the Examiner makes a number of obviousness-type double patenting rejections in view of U.S. Patent No. 6,090,543, U.S. Patent No. 6,090,543 in view of Caskey *et al.* (U.S. Patent No 5,578,458), U.S. Patent No. 5,846,717, U.S. Patent No. 5,846,717 in view of Caskey *et al.* (U.S. Patent No 5,578,458), U.S. Patent No. 6,348,314, U.S. Patent No. 6,348,314 in view of Caskey *et al.* (U.S. Patent No 5,578,458), and provisional obviousness-type double patenting rejections in view of U.S. Application No. 09/381,212, U.S. Application No. 10/290,386, and U.S. Application No. 10/290,386 in view of Caskey *et al.* (U.S. Patent No 5,578,458). In accord with 37 CFR 1.321c and 37 CFR 1.130b, all inventors have herein filed notification of assignment of ownership of the instant invention to Third Wave Technologies, Inc. Because U.S. Patent Nos. 6,090,543, 5,846,717, 6,348,314, and U.S. Application Nos. 09/381,212 and 10/290,386 are commonly owned, Applicants herein file a terminal disclaimer to overcome the rejections. Applicants respectfully ask that these rejections be removed (TAB 4). Should the Examiner believe that a telephone

PATENT

Attorney Docket No. **FORS-04905**

Patent Application Serial No.: **09/713,601**

interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect at (608) 218-6900.

Dated: 5/12/04



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